

REMARKS

Claims 61, 64, 66, 68, 81-88 are pending in the application and are rejected in this Office Action.

Claims 61, 64, 66, 68, 81-88 have been amended to remove the term "nail enamel" from the preamble and bring the term into the body of the claim. Support for this amendment can be found in the claims as previously filed.

Rejections Under 35 U.S.C. §103

The Examiner rejects claims 61, 64, 66, 68, 83, 85 and 87 under 35 U.S.C. §103(a) as being unpatentable over Strella et al. US 3,928,656 (the '656 patent) in view of Ohno 5,854,365 in view of Perronin et al. US 3,991,007 (the '007 patent) as evidenced by US 5,798,426.

The Examiner rejects claims 61, 64, 66, 68, 81-88 under 35 U.S.C. 103(a) as being unpatentable over Perronin et al. (3,991,007) in view of Strella (3,928,656) as evidenced by US 5,798,426.

The Examiner rejects claims 61, 64, 66, 68, 81-88 under 35 U.S.C. 103(a) as being unpatentable over Perronin et al. (3,991,007) as evidenced by US 5,798,426.

The Examiner states, "Strella discloses a method of developing electrostatic latent images with pressure sensitive toner. The toner comprises 19 parts of an ionic polymer (15.8%), 100 parts of tetrahydrofuran (ether solvent-83.3%), and 1 part Mogul black (pigment- 0.8%). See example 1, column 9. The ionic polymer discloses id butyl methacrylate-acrylic copolymer (94.2/5/8) with a TG of 46 degrees Celsius. See examples II. The examiner utilizes this intermediate composition to reject the claims. Strella teaches the use of a pigment or dye such as carbon black, a commercial red, blue, or yellow dye, or any other well-known pigment in an amount of 1-20%. See column 6, lines 4-16."

The Examiner states, "Ohno teaches a toner composition wherein the pigment may be carbon black, an aniline black, acetylene black, naphthol yellow, Hansa yellow, rhodamine lake,

alizarin lake, iron oxide red, phthalocyanine blue and indanthrene blue in the amount of 0.1-20%. See column 22, lines 25-40."

The Examiner states, "It would have been obvious to one of ordinary skill in the art at the time the invention was made to look at the guidance provided by Perronin and utilize either methyl methacrylate or instant butyl methacrylate. One would have been motivated to do so since Perronin teaches several monomers may be copolymerized such as esters of methacrylic acids including methyl and butyl. Thus a skilled artisan would have been motivated to substitute the exemplified methyl methacrylate with butyl methacrylate, substitute the exemplified methyl with butyl, since both are analogous compounds, i.e. both are alkyl esters of methacrylic acids. Therefore, absent unexpected results, substituting the prior art's methyl with instant butyl is deemed obvious to a skilled artisan."

The Examiner states, "it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Strella, Ohno, and Perronin and substitute tetrahydrofuran with the claimed solvents. One would have been motivated to do so since Perronin teaches tetrahydrofuran and the claimed solvents are utilized as the organic solvents for the copolymers."

The Examiner states, "With regard to the copolymer molecular weight, the substitution of methyl for butyl will provide a molecular weight of about 68,000. The examiner cites US 5,798,426 as art of interest wherein '426 states that BMA/AA (90/10) has a weight of 69,400, which reads on about 68,000."

The legal conclusion, that a claim is obvious within § 103(a), depends on at least four underlying factual issues: (1) the scope and content of the prior art; (2) differences between the prior art and the claims at issue; (3) the level of ordinary skill in the pertinent art; and (4) evaluation of any relevant secondary considerations. *Id.*, citing *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966).

A *prima facie* case of obviousness can be rebutted by presenting comparative test data showing that the claimed invention possesses unexpectedly improved properties or properties that the prior art does not have. If a person of ordinary skill in the art would have been surprised by applicant's results, then the invention could not have been obvious. "The principle applies most often to the less predictable fields, such as chemistry, where minor changes in a product or process may yield substantially different results." *In re Mayne*, 104 F.3d 1339, 1343 (Fed. Cir. 1997), quoting *In re Soni*, 54 F.3d 746, 750, 34 U.S.P.Q.2d 1684, 1687 (Fed. Cir. 1995).

In support of the unobviousness applicant provides objective evidence of unexpected results with the submission of a Declaration under 37 C.F.R. §1.132.

[A] *prima facie* case of obviousness can be rebutted if the applicant (1) can establish the existence of unexpected properties in the range claimed, or (2) can show that the art in any material respect taught away from the claimed invention.

In re Geisler, 116 F.3d at 1469, 43 U.S.P.Q.2d at 1364.

In the accompanying Declaration under 37 C.F.R. §1.132, applicant has demonstrated that the problem of long wear in nail enamel has been solved in this application. Applicant has demonstrated in a series of experiments that all monomers do not demonstrate the long wear qualities that are the subject of this invention and therefore it would not have been obvious to use the monomers listed in Perronin to make the long wear nail enamels claimed in this application.

In selecting Strella and Ohno as prior art the Examiner has selected references from such diverse arts (i.e. nonanalogous arts to the claimed invention, toner for printing) that a person of ordinary skill in the claimed art (nail enamel) would not look to those arts to solve the problem treated by the claimed invention.

The selected references directed to the printing industry do not teach the source of the problem (long wear in nail enamel), and the recognition of the source of the problem is what is unobvious.

Applicants have demonstrated that differences between the prior art and the claims at issue in the attached experiments and have also shown that the level of

ordinary skill in the pertinent art would not have been able to combine Stella, Ohno, and Perronin to achieve the nail enamel of applicant's invention.

In view of the above amendments and remarks, Applicants respectfully submit that this application is now in condition for allowance and earnestly request such action.

If any points remain at issue which can best be resolved by way of a telephonic or personal interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

Respectfully Submitted,



Joy S. Goudie
Attorney for Applicants
Reg. No. 48,146
Revlon Consumer Products Corporation
237 Park Avenue
New York, New York 10017
(212) 527-5647